



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,414	10/16/2001	Naomi Nakao	G30-001	4506

7590 10/03/2003  
COLEMAN SUDOL SAPONE, P.C.  
714 Colorado Avenue  
Bridgeport, CT 06605-1601

EXAMINER

LANDREM, KAMRIN R

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,414

Applicant(s)

NAKAO, NAOMI

Examiner

Kamrin R. Landrem

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on July 28, 2203.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 25-27 is/are rejected.
- 7) ☐ Claim(s) 6-8 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 11-24 have been cancelled leaving amended claims 1-10 and new claims 25-29 pending for examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ledergerber (USPN 6,187,043).

With regards to amended Claim 1, Ledergerber does disclose in Figure 25 a prosthesis comprising a body member made of biocompatible material, the body member have a plurality of inflatable chambers 144,148. Chamber 148 is positioned on the upper side of the breast relative to chambers 144 positioned on the lower portion of the breast. Chambers 144 are differently shaped than chamber 148. In Figure 18 Ledergerber discloses fluid guide element 98 enabling differential filling of each of said chambers (9:59- 10:20).

#### ***Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledergerber in view of Chaglassian (USPN 4,773,909).

As discussed above, Ledergerber disclose the prosthesis as claimed however Ledergerber fails to disclose a valve that enables fluid communication between adjacent chambers. With reference to Figure 2, Chaglassian teaches a body member 1 composed of a biocompatible material having a plurality of inflatable chambers 5,6,7 and a plurality of fluid guide elements 2,3,4 connected to chambers 5,6,7 thereby enabling differential filling of said chambers with a fluid. Valve 12 is disposed between chamber 5 and 6 to enable transfer of fluid between chambers 5 and 6 (6:32-46). Therefore in view of the teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated valves between adjacent chambers as taught by Chaglassian into the prosthesis as disclosed by Ledergerber in order to allow fluid communication and differential filling between adjacent chambers. Chaglassian fails to disclose a plurality of valves however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a plurality of valves to interconnect a plurality of chambers to enable fluid communication and differential filling of all chambers since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (see MPEP 2144.04)

***Response to Arguments***

Applicant's arguments filed July 28<sup>th</sup> with regards to 102(e) rejection of claims 1-5 and 9 have been fully considered but they are not persuasive. Ledergerber does disclose the prosthesis as claimed (see body of rejection).

Applicant's arguments with respect to new claims 25 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

Claims 29 allowed.

Claims 6,7,8, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamrin R. Landrem whose telephone number is 703-305-8061. The examiner can normally be reached on 8:00-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/978,414  
Art Unit: 3738

Page 5

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Kamrin Landrem  
Examiner  
AU 3738

KRL



David C. Jacobson  
Primary Examiner